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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,387	03/29/2004	Takeshi Funahashi	Q80738	3077
23373 7590 04/18/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER LOUIE, OSCAR A	
			ART UNIT 2109	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	
3 MONTHS			04/18/2007	
			DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/811,387

Applicant(s)

FUNAHASHI, TAKESHI

Examiner

Oscar A. Louie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/04; 04/06</u> | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This first non-final action is in response to the original filing of 03/29/2004. Claims 1-8 are pending and have been considered as follows.

#### ***Examiner's Note***

1. The Applicant appears to be attempting to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph in Claims 1 & 4-8 by using "means-plus-function" language. However, the Examiner notes that the only "means" for performing these cited functions in the specification appears to be computer program modules. While the claims pass the first test of the three-prong test used to determine invocation of paragraph 6, since no other specific structural limitations are disclosed in the specification, the claims do not meet the other tests of the three-prong test. Therefore, 35 U.S.C. 112 6<sup>th</sup> paragraph has not been invoked when considering these claims below.

#### ***Drawings***

2. The drawings are objected to because Figure 2 contains the term "Minitor" which is an obvious typo and should be corrected to read "Monitor." Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from

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the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

3. The disclosure is objected to because of the following informalities: Page 6 line 2 of the specification recites "FD, CD-R, and MO." These acronyms must include clear definitions as not to be confused with any unintended meaning(s). Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Jain (US-5559888-A).

Claim 1:

Jain discloses an image sending device having a sending means for sending a medical image, to which supplementary information including patient privacy information is attached, to an external device comprising,

- “a separating means for separating the medical image into the supplementary information and an image body” (i.e. “Basic to the invention is the capability of the system to enable selective access to the information stored in the data bases 20, 22 and 24”) [column 2 lines 43-45].
- “a transmission control means for controlling the sending means so that the sending means sends the supplementary information using a higher security transmission method compared to a transmission method for sending the image body” (i.e. “The control program for the system will allow access to the information in data base 24 only to persons having a Security Category 3 identification number that can be entered into the network by conventional DTMF tones”) [column 3 lines 9-11].

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Claim 2:

Jain discloses an image sending device having a sending means for sending a medical image, to which supplementary information including patient privacy information is attached, to an external device as in Claim1 above further comprising,

- “the higher security transmission method is a transmission method that encrypts the supplementary information using a more sophisticated encryption method compared to an encryption method for encrypting the image body” (i.e. “The control program for the system will allow access to the information in data base 24 only to persons having a Security Category 3 identification number that can be entered into the network by conventional DTMF tones. The information in data base 24 is highly confidential and is stored and also transmitted in encrypted form”) [column 3 lines 9-13].

Claim 3:

Jain discloses an image sending device having a sending means for sending a medical image, to which supplementary information including patient privacy information is attached, to an external device as in Claim1 above further comprising,

- “the higher security transmission method is a transmission method for sending the supplementary information using a higher security communication circuit compared to a communication circuit for sending the image body” (i.e. “The control program for the system will allow access to the information in data base 24 only to persons having a Security Category 3 identification number that can be entered into the network by conventional DTMF tones”) [column 3 lines 9-11].

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Claim 4:

Jain discloses an image sending device having a sending means for sending a medical image, to which supplementary information including patient privacy information is attached, to an external device as in Claim 1 above further comprising,

- “a selection accepting means for accepting a selection of a first transmission method that encrypts the supplementary information using a more sophisticated encryption method compared to an encryption method for encrypting the image body and/or a second transmission method for sending the supplementary information using a higher security communication circuit compared to a communication circuit for sending the image body as the high security transmission method” (i.e. “The control program for the system will allow access to the information in data base 24 only to persons having a Security Category 3 identification number that can be entered into the network by conventional DTMF tones. The information in data base 24 is highly confidential and is stored and also transmitted in encrypted form”) [column 3 lines 9-13].
- “the transmission control means controls the sending means so that the sending means sends the supplementary information using the transmission method which has been accepted by the selection accepting means” (i.e. “The control program for the system will allow access to the information in data base 24 only to persons having a Security Category 3 identification number that can be entered into the network by conventional DTMF tones”) [column 3 lines 9-11].

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Claim 5:

Jain discloses an image receiving device comprising,

- “a receiving means for receiving the supplementary information and the image body which have been sent by the image sending device” (i.e. “The computer 12 is illustrated in FIG. 1”) [column 2 line 36].
- “an associating means for associating the supplementary information with the image body” (i.e. “The selection of which level of security the particular information is stored is a function of the subscriber's requirements”) [column 2 lines 53-55].

Claim 6:

Jain discloses an image sending device having a sending means for sending a medical image, to which supplementary information including patient privacy information is attached, to an external device comprising,

- “a separating means for separating the medical image into the supplementary information and an image body” (i.e. “Basic to the invention is the capability of the system to enable selective access to the information stored in the data bases 20, 22 and 24”) [column 2 lines 43-45].
- “a transmission control means for controlling the sending means so that the sending means sends only the image body” (i.e. “The control programs for the computer 12 will allow access to the information in data base 20 to anyone having a Security Category 1 identification number that can be entered into the telephone network by depressing the touch tone keypad, which transmits conventional DTMF tones”) [column 2 lines 56-60].



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Claim 7:

Jain discloses an image sending device having a sending means for sending a medical image, to which supplementary information including patient privacy information is attached, to an external device as in Claim 6 above further comprising,

- “a recording means for recording the supplementary information in a recording medium” (i.e. “a high capacity secure storage computer 12 and means 14 to interface between the network 10 and the computer”) [column 2 lines 25-27].

Claim 8:

Jain discloses an image sending device having a sending means for sending a medical image, to which supplementary information including patient privacy information is attached, to an external device as in Claim 6 above further comprising,

- “a print-out means for printing out the supplementary information” (i.e. “The computer 12 is illustrated in FIG. 1”) [column 2 line 36].

### ***Conclusion***


6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Oscar Louie whose telephone number is 571-270-1684. The examiner can normally be reached Monday through Thursday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, James Myhre, can be reached at 571-270-1065. The fax phone number for Formal or Official faxes to Technology Center 2100 is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OAL  
04/12/2007

  
James Myhre  
Supervisory Patent Examiner